

REMARKS

Claim 1 has been amended, without prejudice or disclaimer, to correct an obvious minor typographical error. No new matter has been introduced. Fifteen (15) claims are pending and remain for consideration. Favorable reconsideration of the pending claims and further examination of the application is respectfully requested.

Objection to the Specification

The disclosure is objected to because the heading on top of page 3 labeled "Brief Description" appeared to be erroneous and is believed to be the "Detailed Description" of the invention. An appropriate correction was required. The disclosure has been amended, without prejudice or disclaimer, to correct the heading to read "Detailed Description" as suggested. The amendment has not been made to overcome a prior art rejection and does not present new issues for consideration.

Information Disclosure Statement

The Examiner indicates that the listing of U.S. Patent No. 5,485,760 in the specification did not form a proper information disclosure statement under 37 CFR 1.98(b) and that the patent is not cited separately in any information disclosure statement filed by Applicants. Applicants acknowledge that the Examiner has cited the patent on a form PTO-892 to correct this issue.

35 U.S.C. § 102(e)

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2002/0149268, to Yamada et al. This rejection is respectfully traversed.

In order for a claim to be anticipated under 35 U.S.C. §102, each and every element, as set forth in the claim, must be found, either expressly or inherently, in a single prior art reference (*Verdegaal Bros. v Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)); the identical invention must be shown in as complete

detail as is contained in the claim (*Richardson v Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)); and the elements must be arranged as required by the claim (*In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Claim 1 is directed to an actuator comprising a motor, an actuator member, and an assist mechanism. The actuator member is operatively connected to the motor for moving the actuator member in an extended direction and a retracted direction. The assist mechanism comprises an assist element that is adapted to store energy to assist in moving the actuator member. The assist element is carried between two abutment members that act upon the assist element to cause the assist element to store energy when the actuator member is moved in the extended direction and release the energy when the actuator member is moved in the retracted direction opposite to the extended direction.

Yamada et al. fail to disclose an assist element carried between two abutment members that act upon the assist element to cause the assist element to store energy when the actuator member is moved in the extended direction and release the energy when the actuator member is moved in the retracted direction, as set forth in claim 1.

The Examiner argues that Yamada et al. disclose a motor 2 for moving an actuator member (i.e., ball screw 4) in extended and retracted directions and an assist element (i.e., spring 11) carried between two abutment members (i.e., guide member 8 and gear casing 10). However, the spring 11 does not store energy when the ball screw 4 is moved in the extended direction and release the energy when the ball screw 4 is moved in the retracted direction, as set forth in claim 1. Instead, the spring 11 stores energy when the ball screw 4 is moved in the retracted direction and releases the energy when the ball screw 4 is moved in the extended direction (see page 4, paragraph 0048).

The Examiner gives no patentable weight to the limitation that the abutment members act upon the assist element to cause the assist element to store energy when the actuator member is moved in the extended direction and release energy when the

actuator member is moved in the retracted direction, arguing that the limitation is functional, and appears to be drawn to a method of use rather than the structure of the device. The Examiner also argues that, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, citing MPEP 2114 and *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The Examiner further argues that "apparatus claims cover what a device is, not what a device does," citing *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Contrary to the Examiner's argument, *In re Schreiber* does not require apparatus claims to be distinguished from the prior art in terms of structure rather than function. Instead, *In re Schreiber* established that a functional limitation critical for establishing novelty may be an inherent characteristic of the prior art, and as such shifts the burden to the applicant to prove that the subject matter in the prior art does not possess the characteristic relied upon.

In *In re Schreiber*, Schreiber's patent application claimed a device for dispensing popped popcorn. Claim 1 recited a dispensing top for passing only several kernels of popped popcorn at a time from an open-ended container filled with popped popcorn. The examiner rejected the claim as being anticipated by a patent to Harz. The Harz patent disclosed "a spout for nozzle-ready containers," which may be tapered inwardly in a conical fashion. The examiner concluded that the top of Harz was clearly capable of dispensing popped popcorn. Schreiber responded with an argument that the conical dispensing top of Harz was designed for dispensing liquids rather than solids, such as popcorn, and that the top was not large enough to pass popcorn kernels.

On appeal, the Board found that the structure disclosed by Harz was inherently capable of dispensing popcorn in the manner set forth in the claims. The Board distinguished structural and functional claim limitations, stating that a functional

limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art. It shifts the burden to the applicant to prove that the subject matter in the prior art does not possess the characteristic relied upon. The Board found that the examiner was justified in concluding that the opening of the conical shaped top of Harz was inherently of a size sufficient to "allow several kernels of popped popcorn to pass through" and the taper of the top of Harz was inherently of such shape "as to by itself jam up the popped popcorn . . . and permit the dispensing of only a few kernels." The burden then shifted to Schreiber, who failed to disprove the examiner's conclusion.

In the instant application, claim 1 recites an assist element carried between two abutment members that act upon the assist element to cause the assist element to store energy when the actuator member is moved in the extended direction and release the energy when the actuator member is moved in the retracted direction. Yamada et al. does not possess this characteristic for at least the reasons set forth above. In this regard, Applicants have disproven the Examiner's arguments to the contrary, as required by *In re Schreiber*.

With regard to *Hewlett-Packard Co*, apparatus claims are not limited to cover what a device is, not what a device does, as argued by the Examiner. In fact, *Hewlett-Packard Co* has been misapplied for the following reasons. *Hewlett-Packard Co* involved a claim that recited drive and idler wheels spring biased together to cause a rough surface to make a series of indentations along a driven edge of a web. This particular language was the focus of the Appellate Court's attention in determining whether the claim was obvious. Note the similarity in this language and the language of claim 1 of the present application, "the abutment member to cause the assist element to store energy when the actuator member is moved in the extended direction." The Appellate Court decided that the language distinguished the claimed invention from the prior art. The case then turned on whether the invention was obvious, and no evidence of obviousness was offered.

In the present application, the language "the abutment member to cause the assist element to store energy when the actuator member is moved in the extended direction" distinguishes claim 1 from Yamada et al., which fail to disclose the claim limitation. Since Yamada et al. fail to disclose the invention of claim 1, claim 1 is not anticipated by Yamada et al. Consequently, claim 1 should be allowable as presented.

If an independent claim is allowable, then any claim depending therefrom is allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 2-9 depend from claim 1 and should be allowable for at least the same reasons as claim 1, as set forth above. In addition, claim 7 requires one of the abutment members of claim 1 to be in the form of a clamp that is fixed relative to the outer tube.

The Examiner argues that Yamada et al. disclose such a clamp, interpreting a clamp as "any of various instruments or appliances having parts brought together for holding or compressing something," citing Merriam Webster's Collegiate Dictionary, 10th ed., for such an interpretation. Applicants respectfully submit that neither abutment member (i.e., gear casing 10 nor guide member 8) disclosed by Yamada et al. forms of a clamp "having parts brought together," as required by the Examiner's definition. In this regard, Yamada et al. fail to disclose each and every element, as set forth in the claim. Consequently, claim 7 should be allowable over Yamada et al. in its own right.

35 U.S.C. § 103(a)

Claims 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. This rejection is respectfully traversed. Claims 10, 12 and 13 depend from claim 1 and are believed to be allowable for at least the same reasons as claim 1, as set forth above.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of U.S. Patent No. 1,855,227, to Fiege. This rejection is respectfully

traversed. Claim 11 depends from claim 1 and is believed to be allowable for at least the same reasons as claim 1, as set forth above.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada in view of U.S. Patent No. 2,424,198, to Tauscher. This rejection is respectfully traversed. Claims 14 and 15 depend from claim 1 and are believed to be allowable for at least the same reasons as claim 1, as set forth above.

#### Conclusion

In view of the amendments and above remarks, it is believed that the application is in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

#### Request for Telephone Interview

As a final matter, if the Examiner has any suggestions concerning different claim phraseology that, in the opinion of the Examiner, more accurately defines the present invention, prior to issuance of another Office Action, Applicants' undersigned attorney requests the courtesy of a telephone interview at the Examiner's earliest convenience to discuss the application. Applicants' undersigned attorney may be contacted at (419) 255-5900.

Respectfully submitted,

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